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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,203	04/12/2001	Maurice Zauderer	1821.0020001	1700

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EXAMINER
DECLOUX, AMY M

ART UNIT	PAPER NUMBER
1644	5

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/833,203	Zauderer et al.
Examiner	**Art Unit**
DeCloux, Amy	1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-119* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-119* are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other.

Detailed Action

1. A restriction is required under 35 U.S.C. 121 between one of the following groups:

Group I, Claims 1-13, drawn to a compound comprising MHC peptide complexes that comprise an MHC alpha chain linked to the carboxy terminus of said antibody, wherein said MHC-peptide complexes are linked to the carboxy terminus of said antibody, classified in class 435, subclass 7.8,

Group II, Claims 14-26, drawn to a compound comprising MHC peptide complexes that comprise an MHC alpha chain and a beta-2 microglobulin molecule, wherein said alpha chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1.

Group III, Claims 27-39, drawn to a compound comprising MHC peptide complexes that comprise an MHC alpha chain and an MHC beta chain, wherein at least one chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1.

Group IV, Claims 40-58, drawn to a compound comprising two or more MHC peptide complexes, a multivalent compound, and an antibody specific for a cell surface marker, wherein said MHC-peptide complexes comprise that comprise an MHC alpha chain and a beta-2 microglobulin molecule, wherein at least one chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1.

Group V, Claims 40-58, drawn to a compound comprising two or more MHC peptide complexes, a multivalent compound, and an antibody specific for a cell surface marker, wherein said MHC-peptide complexes comprise that comprise an MHC alpha chain and an MHC beta chain, wherein at least one chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1.

Group VI, Claim 59, drawn to a polynucleotide encoding a compound comprising one or more MHC molecules and an antibody, wherein said MHC molecules comprise an MHC alpha chain and a beta-2 microglobulin molecule, wherein the MHC molecules are linked to the carboxy terminus of said antibody, classified in class 435, subclass 7.8,

Group VII, Claim 60, drawn to a polynucleotide encoding a compound comprising one or more MHC molecules and an antibody, wherein said MHC molecules comprise an MHC alpha chain and a beta-2 microglobulin molecule, wherein said alpha chains are linked to the carboxy terminus of said antibody, classified in class 435, subclass 7.8,

Group VIII, Claim 61, drawn to a polynucleotide encoding a compound comprising one or more MHC molecules and an antibody, wherein said MHC molecules comprise an MHC alpha chain and an MHC beta chain, wherein at least one chain is linked to the carboxy terminus of said antibody, classified in class 435, subclass 7.8,

Group IX, Claims 62-74, drawn to a method of immunizing an animal comprising administering one or more MHC peptide complexes that comprise an MHC alpha chain linked to the carboxy terminus of said antibody, wherein said MHC-peptide complexes are linked to the carboxy terminus of said antibody, classified in class 435, subclass 7.8,

Group X, Claims 75-87, drawn to a method of immunizing an animal comprising administering one or more MHC peptide complexes that comprise an MHC alpha chain and a beta-2 microglobulin molecule, wherein said alpha chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1

Group XI, Claims 88-100, drawn to a method of immunizing an animal comprising administering one or more MHC peptide complexes that comprise an MHC alpha chain and an MHC beta chain, wherein at least one chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1.

Group XII, Claims 101-119, drawn to a method of immunizing an animal comprising administering one or more MHC peptide complexes that comprise two or more MHC peptide complexes, a multivalent compound, and an antibody specific for a cell surface marker, wherein said MHC-peptide complexes comprise that comprise an MHC alpha chain and a beta-2 microglobulin molecule, wherein at least one chain is linked to the carboxy terminus of said antibody, classified in class 424, subclass 278.1.

Note: Each claim will be examined only to the extent of the elected invention (see Groups IV and V).

2. The inventions are distinct, each from the other because:

Groups IX-XII are unique methods because each of said methods comprises administering a unique MHC complex, and thus said groups comprise different ingredients. Therefore, groups IX-XII are patentably distinct, each from the other.

Groups I-VIII are unique products. Groups I-V are comprised of proteins while Groups VI-VIII are comprised of nucleic acid. Groups I-V are distinct because each encompasses a unique MHC complex, which accordingly has a unique set of properties, structure and biochemical functions. Groups VI-VIII encode MHC molecules that are distinct, and therefore, the nucleotide sequence the polynucleotide

encompassed by each group is distinct. Therefore, Groups I-VIII are patentably distinct, each from the other.

Inventions I and IX are related as product and process of use, as are Inventions II and X, as are Inventions III and XI, as are Inventions IV and XII. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the MHC products as claimed in each of Groups I-IV, can be used as a ligand in a materially different process such as immunopurification or immunodetection procedures, as well as in a method of immunizing an animal.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and because a search in the non-patent literature of any of these distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the Examiner, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention.

Regardless of which group is elected, the applicant is further required under 35 U.S.C. 121:

to elect a product or a method comprising a **specific cell surface marker** such as one recited in claim 4,

and

to elect a product or a method comprising a **specific antigenic peptide**, such as one disclosed in Table 6 of the instant specification :

5. Claims 1-119 are generic, in at least one aspect.

6. The species are distinct each from the other for the following reasons:

Cell surface markers and antigenic peptides differ with respect to their biochemical structure and function,

7. Applicant is required, in response to this action, to elect a specific species to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims

are generic is considered non-responsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. a message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Amy DeCloux, Ph.D.
Patent Examiner
Group 1640, Technology Center 1600
July 1, 2002